

REMARKS

Claims 1-19 are pending in this application. Claims 1, 4, 12-14, and 18 have been rejected as anticipated by Barnert (U.S. Patent No. 3,934,564). Claims 5-8, 10, 11, 15, and 16 have been rejected as obvious over Barnert in view of Kreuter et al. (U.S. Patent No. 4,794,847). Claims 2, 3, 17, and 19 have been rejected as obvious over Barnert. Claim 9 has been objected to as being dependent upon a rejected base claim, but has been indicated to contain allowable subject matter. Accordingly, claim 9 has been rewritten in independent form. Applicants respectfully traverse the rejection of claims 1-8 and 10-19, and request reconsideration.

The examiner rejected claims 1, 4, 12-14, and 18 under 35 U.S.C. § 102(b) as being anticipated by Barnert. Applicants respectfully traverse this rejection, and request reconsideration. Applicants have amended claims 1, 14, and 18 to help clarify the invention that is claimed. Specifically, independent claim 1 has been amended to recite an exhaust gas recirculation valve that includes, *inter alia*, "a valve element pivotally mounted entirely within the exhaust passage tube." Similarly, independent claim 14 has been amended to recite an exhaust gas recirculation valve that includes, *inter alia*, "a valve element pivotally mounted entirely within the exhaust passage tube." Still further, independent claim 18 has been amended to recite a method of actuating an exhaust gas recirculation valve that includes, *inter alia*, "mounting a valve element entirely within an exhaust passage tube." The amendments to claims 1, 14, and 18 are intended to clarify the invention that is claimed, and are not intended to narrow the scope of the claims. Support for these amendments may be found, for example in Figs. 2 and 5.

Barnert fails to teach or suggest a valve element mounted entirely within an exhaust passage tube. Instead, the plates 11, 12, and 26 of Barnert extend outside of the exhaust line 2, thus resulting in a bulky structure. To the contrary, an exhaust gas recirculation valve that includes a valve element mounted entirely within an exhaust passage tube, as recited in claims 1, 14, and 18 of applicants' unique invention, provides a compact configuration. See p. 5, para. [25]. Claims 1, 14, and 18 are thus allowable. Claims 2-8 and 10-13 dependent on claim 1, claims 15-17 dependent on claim 14, and claim 19 dependent on claim 18, are also allowable.

For at least these reasons, claims 1, 4, 12-14, and 18 are allowable, and such action is solicited.

The examiner rejected dependent claims 5-8, 10, 11, 15, and 16 under 35 U.S.C. § 103(a) as being obvious over Barnert in view of Kreuter et al. Indeed, there is no basis for contending that the combination of Barnert and Kreuter et al. renders the rejected claims obvious, since neither Barnert nor Kreuter et al. discloses or suggests the subject matter of the rejected claims. For example, neither Barnert nor Kreuter et al. discloses or suggests a valve element pivotally mounted entirely within an exhaust passage tube, as recited in independent claims 1 and 14 (and, therefore dependent claims 5-8, 10, 11, 15, and 16). Because this feature is neither taught nor suggested in the combination of Barnert and Kreuter et al., applicants respectfully submit that claims 5-8, 10, 11, 15, and 16 cannot be obvious therefrom.

The examiner rejected dependent claims 2, 3, 17, and 19 under 35 U.S.C. § 103(a) as being obvious over Barnert. As discussed above, applicants' independent claims 1 and 18 (and, therefore dependent claims 2, 3, 17, and 19), all recite the limitation of a valve element mounted entirely within an exhaust passage tube. Because this feature is neither taught nor suggested in Barnert, applicants respectfully submit that claims 2, 3, 17, and 19 cannot be obvious therefrom.

Because none of the cited references, considered alone or in combination, discloses or suggests all of the elements of the claims at issue, and further because the references fail to disclose or suggest that it would be desirable or even possible to combine features of one with another to arrive at the claimed combination of elements, it follows that a *prima facie* case of obviousness has not been established. *See In re Sernaker*, 217 U.S.P.Q. 1 (Fed. Cir. 1983) and *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Inter. 1985). Accordingly, the rejection of claims 2, 3, 5, 8, 10, 11, 15-17, and 19 is improper, and should be withdrawn.

Enclosed is a check in the amount of \$86.00 for payment of the fee associated with the additional independent claim pursuant to this amendment.

In view of the foregoing, applicants respectfully request reconsideration and withdrawal of the rejection of claims 1-8 and 10-19. Should the examiner wish to discuss the foregoing, or any matter of form in an effort to advance this application toward allowance,

the examiner is urged to telephone the undersigned at the indicated number.

Respectfully submitted,

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